REMARKS

Entry of the foregoing amendment and reconsideration of the application, pursuant to and consistent with the Rules of Practice in Patent Cases, in light of the remarks which follow, is respectfully requested. Upon entry of the amendment, claims 1-11 and 26-36 will be pending.

The objection to the specification for various formalities is respectfully traversed in view of the above amendments.

The rejection of claims 3, 6, and 11 under 35 U.S.C. §112, second paragraph, is respectfully traversed in view of the above amendments.

Claims 1-2, 5, and 9 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,143,122 to Mossbeck et al. ("Mossbeck"). Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Mossbeck and further in view of the collective teachings of U.S. Patent No. 5,792,309 to Eto ("Eto") and Published PCT Application WO 96/07345 in the name of St. Clair ("St. Clair"). Claim 7 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Mossbeck and further in view of U.S. Patent No. 5,016,305 to Suenens et al. ("Suenens"). Claims 1-5 and 7-11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Suenens in view of Mossbeck. Claim 6 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Suenens and Mossbeck, and further in view of the collective teachings of Eto, EP 421495 to Suenens ("Suenens II"), and U.S. Patent No. 6,159,319 to Mossbeck ("Mossbeck II"). Each of these rejections is respectfully traversed.

Each of the prior art rejections set forth in the January 29, 2004 Office Action relies on Mossbeck as either a first or secondary reference. As demonstrated by the accompanying Declaration of Ian James Whitworth Under 37 C.F.R. § 1.131 ("Whitworth Declaration"), Mossbeck is not prior art against the present invention, because applicant conceived his invention prior to September 15, 1998, the earliest claimed priority date of Mossbeck, and used due diligence from prior to September 15, 1998 to the filing of the present application.

As is established in the Whitworth Declaration, applicant conceived, in the U.K. (a WTO member country), prior to September 15, 1998, the invention claimed in the

above-identified patent application, and from prior to September 15, 1998, diligently reduced it to practice through the filing of the present patent application (Whitworth Declaration ¶¶ 4, 5, 6, and 7). Evidence of conception prior to September 15, 1998, is provided in Exhibit 3 attached to the Whitworth Declaration. Exhibit 3 is a true copy of a schematic drawing of the claimed invention prepared by applicant prior to September 15, 1998 for a meeting with a first U.K. Chartered Patent Attorney (Whitworth Declaration ¶ 5). During this meeting, applicant was advised that the invention was not patentable and that it would infringe an existing EP Patent (Whitworth Declaration ¶ 5). In light of this advice, applicant took no action to reduce the invention to practice at that time (*Id.*)

Evidence of applicant's due diligence from prior to September 15, 1998 to the filing of the present patent application is provided in Exhibits 4, 5, 1, and 2. Exhibits 4 and 5 relate to a meeting between applicant and a second U.K. Chartered Patent Attorney. Exhibit 4 is a true copy of the attorney's diary showing the meeting, and Exhibit 5 is a true copy of the attorney's file note relating to the meeting (Whitworth Declaration ¶ 6). During this meeting, applicant was encouraged to proceed with the preparation and filing of a U.K. patent application, and such an application was timely filed (*Id.*). The present patent application claims priority to this U.K. filing (Whitworth Declaration ¶ 2). Exhibits 1 and 2 are, respectively, true copies of the filing receipt issued by the United States Patent and Trademark Office for the present patent application, and of the bibliographic details cover page published by the International Bureau of the World Intellectual Property Organization for PCT/GB00/00917, the international application from which the present patent application is derived.

Under 35 U.S.C. §102(e), a person is entitled to a patent unless ". . . the invention was described in — (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent . . ." According to M.P.E.P §706.02(b), however, a "rejection based on 35 U.S.C. §102(e) can be overcome by: . . . (D) Filing an affidavit or declaration under 37 C.F.R. §1.131 showing prior invention." According to 37 C.F.R. §1.131(b), the "showing of facts shall be such, in character and weight, as to establish . . . conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to . . . the filing of the

application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration . . ."

Since applicant conceived the presently claimed invention prior to September 15, 1998, the earliest claimed filing date of Mossbeck, and since applicant exercised due diligence from prior to September 15, 1998 to the filing of the present patent application, Mossbeck is not valid prior art under 35 U.S.C. §102(e).

Accordingly, each of the rejections that rely upon Mossbeck should be withdrawn.

In view of all of the foregoing, applicants submit that this case is in condition for allowance and such allowance is earnestly solicited.

Respectfully submitted,

Date: June 29, 2004

Candice J. Clement
Registration No. 39,946

NIXON PEABODY LLP
Clinton Square, P.O. Box 31051
Rochester, New York 14603-1051
Telephone: (585) 263-1069
Facsimile: (585) 263-1600

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]

I hereby certify that this correspondence is being:

☒ deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450

☐ transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (703)

June 29, 2004
Date

Ruth R. Smith
Signature

Ruth R. Smith
Type or Print Name